



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/842,371	04/25/2001	Diane C. Breidenbach		6561
7590 Thomas A. O'Rourke BODNER & O'ROURKE 425 Broadhollow Road Melville, NY 11747				
			EXAMINER NGUYEN, TUAN N	
			ART UNIT	PAPER NUMBER
			3751	
			MAIL DATE	DELIVERY MODE
			08/18/2009	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

09/842,371

Applicant(s)

BREIDENBACH ET AL.

Examiner

Tuan N. Nguyen

Art Unit

3751

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 01 June 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-27, 29, 32-49 and 51-54 is/are pending in the application.
- 4a) Of the above claim(s) 32-39 and 51 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-27, 29, 40-49 and 52-54 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/06)
- 4) ☐ Interview Summary (PTO-413)
- 5) ☐ Notices of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____
- Paper No(s)/Mail Date _____

DETAILED ACTION

Response to Arguments

1. Applicant's arguments with respect to claims 1-27, 29 and 40-49 have been considered but are moot in view of the new ground(s) of rejection. The amendment language to define the size and rim of the receptacle is met by the receptacle 12 of Bratby-Carey.

Response to Amendment

2. The affidavit under 37 CFR 1.132 filed 3/23/09 is insufficient to overcome the rejection of claims, as indicated below, based upon the evidence is not commensurate with the scope of the claims as set forth in the last Office action because: in order to be commensurate in scope with the claims, the commercial success must be due to claimed features, and not due to unclaimed features; other equivalent language does not establish a nexus between the claimed invention and the commercial success because there is no evidence that the product which has been sold corresponds to the claimed invention, or that whatever commercial success may have occurred is attributable to the product or process defined by the claims; there is no evidence showing the commercial success alleged is directly derived from the invention claimed; the applicant must show that the claimed features were responsible for the commercial success of an article; and evidence of commercial success must be clearly attributable to the design to be of probative value, and not to brand name recognition. In view of the foregoing, when all of the evidence is considered, the totality of the rebuttal evidence of nonobviousness fails to outweigh the evidence of obviousness.

Claim Objections

3. Claims 1-27, 29, 40-49, and 52-54 are objected to because of the following informalities: The limitation "a said rim" in line 14 of claim 1 is grammatically incorrect. The limitation "essential oils and/or moisture" in line 14 of claim 1 is non-equivalent alternative, it should be just either be --moisture-- or --oils--. Furthermore, claim 1 has already claimed a doe foot applicator on line 16; therefore, claims 8, 11-20, 27, 29, 40, 41 and 52-54 are either redundant or inconsistent. Claim 42 has the same problem as in claim 1, see line 8 for "said a roller ball" and line 9 for "a said rim" and "essential oils and/or moisture" also in line 9,

Appropriate correction is required.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 1-27, 29, 40-49, and 52-54 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Regarding claim 1, it is unclear as to the difference between the "product" in lines 6-7 and the "essential oils and/or moisture" in lines 1-5; furthermore, it is unclear as to the difference between the "rollerball applicator" in line 8 and the "roller ball" in line 14. Regarding claim 42, it is unclear as to the difference between the "product" in lines 3-4 and the "essential oils and/or moisture" in line 9; furthermore, it is unclear as to the difference between the

"rollerball applicator" in line 5 and the "roller ball" in line 8. The claims are being examined as best understood.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 1-27, 29, 40-49, and 52-54 are rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent 5,897,626 (hereinafter Bratby-Carey) in view of US Patent 2,663,891 (hereinafter Hanryon) and US Patent 6,276,856 (hereinafter Pieper).

Bratby-Carey discloses a dual ended container (see Fig. 1) comprising a sleeve (44) that has first and second ends, each of the ends being adapted to receive a receptacle (12, 28) for containing a product, the receptacles is capable of containing any of the specific well known fluid products as claimed, wherein the product in the first receptacle could be different from the product in the second receptacle depend on the user wishes. The intended use with different product and all other functional phrases have been carefully considered but are deemed not to describe any structure patentably distinguishable over the device that disclosed by Bratby-Carey which is certainly capable of being used in the claimed manner. The sleeve (44) of Bratby-Carey has a first section and a second section, which are connected by a sidewall (see Fig. 2). The receptacle (12) has an applicator pad (24) for applying the fluid product in the receptacle and extending into one end of the sleeve and being removably connected to

one end of the sleeve; however, it would have been obvious to one of ordinary skill in the art at the time the invention was made to replace the applicator pad of Bratby-Carey with a rollerball applicator (2) of Hanryon having a roller ball (7) and a spring (15) to upwardly press the ball (7) against its seat (6) to provide a seal (see col. 2, line 30 et seq.), where in so doing would involve mere substitution of one functional equivalent applicator head for another and the selection of any of these known equivalents to apply a fluid onto a surface would perform equally well on the Bratby-Carey device. The second end of the sleeve (44) has a rod (58) extending therefrom, the rod has the brush (42) attached thereto instead of a doe foot; however, it would have been obvious to one of ordinary skill in the art at the time the invention was made to replace the brush (42) applicator of Bratby-Carey with a doe foot applicator (56) of Pieper, where in so doing would involve mere substitution of one functional equivalent applicator head for another and the selection of any of these known equivalents to apply a fluid onto a surface would perform equally well on the Bratby-Carey device. The other claimed features such as the sidewall of the first receptacle is parallel to the sidewall of the second receptacle, the center axis, and the cross section shape are clearly shown and anticipated by Bratby-Carey. The brush (42) of Bratby-Carey can be called "a mascara brush" since no structure is claimed to distinguish therefrom.

Conclusion

7. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP

§ 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tuan N. Nguyen whose telephone number is 571-272-4892. The examiner can normally be reached on Monday-Friday (10:00-6:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gregory Huson can be reached on (571) 272-4887. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/Tuan N Nguyen/
Primary Examiner, Art Unit 3751

TN